

REMARKS

This paper is responsive to the non-final Office Action dated October 31, 2008 (the "Office Action").

Claims 1-3, 5, 7-10, 12-18, 24-27, 31, 33-35, 39, 41-43, 45-48, 55-57, and 59-71 are pending, including new claims 68-71. Previously pending claims 51 and 58 have been canceled in this paper.

Claims 1-3, 5, 7-10, 12-18, 24-27, 31, 33-35, 39, 41-43, and 45-48 previously stood rejected.

Claim 54 was previously under objection.

The amendments add no new matter. Support for the amendments can be found throughout the specification, for example in ¶¶ 28, 61-72, and 157. While not conceding that the cited reference(s) qualify as prior art, but instead to expedite prosecution, Applicant has chosen to respond as follows. Applicant reserves the right, for example in a continuing application, to establish that the cited reference(s), or other references cited thus far or hereafter, do not qualify as prior art as to an invention embodiment previously, currently, or subsequently claimed.

The amendments to the claims have been made to expedite prosecution. Applicant reserves the right, for example in a continuing application, to pursue the previously pending claims or claims similar thereto. Applicant respectfully submits that the pending claims are allowable in view of the following remarks and the above amendments, and respectfully requests reconsideration of the pending rejections.

Formal Matters

Applicant is grateful for the opportunity provided to the undersigned representative to discuss the claims with the Examiner during a telephonic interview initiated by Examiner Robert M. Pond on October 24, 2008. This interview related to the claims previously submitted with Applicant's Request for Continued Examination on July 16, 2008.

On October 28, 2008, Examiner Pond contacted the undersigned to propose a follow-up telephonic interview. The Examiner also indicated that he would send a written notice proposing this telephonic interview. This written proposal appeared in the Office Action dated October 31, 2008. The undersigned and the Examiner subsequently held the follow-up telephonic interview on November 10, 2008.

Although no agreement on the patentability of the claims was reached during these discussions, Applicant is grateful for the Examiner's comments regarding the pending claims and the cited references, and for the Examiner's observations regarding possible claim amendments that would further the prosecution of the application. In particular, the Examiner proposed that it may be possible to overcome the cited references by, among others, amending the claims to clarify operations that can occur prior to "a runtime session." Applicant has made the above amendments with these discussions in mind, and believes that these amendments address the concerns related by the Examiner.

Moreover, Applicant is grateful for the clarification that Applicant's previous amendments of July 16, 2008—which were accompanied by a Request for Continued Examination (RCE)—have been entered. The above amendments are therefore presented as changes with respect to those previous amendments.

The above amendments and the following remarks are presented in furtherance of the discussions with the Examiner during the telephonic interviews, and also in response to the Office Action dated October 31, 2008.

Objections Regarding Elected Subject Matter

The Office Action expresses a concern that Applicant's previous amendments of July 16, 2008 included amendments that switched from the elected invention that was under examination. In particular, the Office Action posits that the added claim language of "during a runtime session" may shift the independent claims from addressing a "generating a product configurator" to "using a product configurator."

Applicant respectfully submits that the previous amendment does not impermissibly change the scope of the invention to cover non-elected subject matter, since the amendment in question added a limitation (that various operations that were under examination occur "during a runtime session"). The addition of such claim language only narrows the scope of the claim under examination. Narrowing an elected independent claim does not a shift the scope of the claim to non-elected subject matter.

Moreover, Applicant's claims as originally filed included limitations such as:

"receiving a request to associate a first component product from the set of one or more component products with the customizable product instance" and "determining whether to associate the first component product from the set of one or more component products with the customizable product instance"

(original claim 1, emphasis added);

"providing a user interface for each component product"

(original claim 5, emphasis added);

“the user interface includes a theme UI, a control UI, and a group UI”

(original claim 6, emphasis added); and

“the customizable product includes component product information to guide a consumer in the selection of the customizable product”

(original claim 22, emphasis added). These original claim limitations make abundantly clear that one or more of the elected claims, as originally presented, did indeed include limitations relating to operations through a user interface during interactions with a consumer or other user, such as “guid[ing] a consumer in the selection of the customizable product” (original claim 22). The presence of these limitations further highlights the fact that Applicant’s amendments of July 16, 2008 did not impermissibly change the subject matter of the pending claims by adding claim language relating to interactions that occur during a runtime session.

Accordingly, Applicant respectfully requests that the pending objection to Applicant’s previous response be withdrawn.

Nonetheless, to further the prosecution of the present application—and as agreed during the above-noted telephonic discussions with the Examiner—Applicant has amended the claims to remove the claim language of “during a runtime session” from the independent claims. In view of these amendments, Applicant respectfully submits that the objection in the pending Office Action is moot.

Claim Objections

Claim 54 was previously under objection under 37 C.F.R. 1.75(c) as being of improper dependent form. As fully explained in Applicant's previous response (submitted with the Request for Continued Examination of July 16, 2008), Applicant has canceled claim 54, and submits that the claim objection is therefore moot.

Rejections under 35 U.S.C. § 112, second paragraph

Claim 54 previously stood rejected under 35 U.S.C. § 112, second paragraph, as purportedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. As fully explained in Applicant's previous response (submitted with the Request for Continued Examination of July 16, 2008), Applicant has canceled claim 54, and the rejection under § 112, second paragraph, is therefore moot.

Rejections under 35 U.S.C. § 103(a)

Claims 1-3, 5, 7-10, 12-18, 24-27, 31, 33-35, 39, 42-43, 46-47, and 51 previously stood rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over U.S. Patent No. 6,035,305 issued to Strevey et al. ("Strevey") in view of U.S. Patent No. 5,980,096 issued to Thalhammer-Reyero et al. ("Thalhammer-Reyero"). Claims 41, 45, and 48 previously stood rejected under § 103(a) as purportedly being unpatentable over Strevey in view of Thalhammer-Reyero and further in view of U.S. Patent No. 5,884,217 issued to Skeirik et al. ("Skeirik").

As fully explained in Applicant's previous response (submitted with the Request for Continued Examination of July 16, 2008), the claims are allowable under § 103(a) because the

cited passages of the references, whether taken individually or in combination, failed to disclose each limitation of Applicant's pending claims.

Moreover, amended independent claim 1 now includes:

receiving a template comprising identifiers and operators, wherein:

the identifiers identify one or more component products from a set of component products, and

the identified component products comprise a first component product, and generating a customizable class rule based on the identifiers and on relationships associated with the operators.

These limitations have been added following the above-noted discussions between the Examiner and Applicant's undersigned representative. Examples are provided in Applicant's Specification (e.g., ¶¶ 63-74, among others) of implementations of systems that use templates with operators (such as "less than," "and," "requires," "then include," "if," and others) and identifiers (such as identifiers for component products, identifiers for numbers, "Good Customer," "Computer X," "shipping destination," and others).

Applicant respectfully submits that these amendments introduce limitations that are also absent from the cited passages of Strevey or Thalhammer-Reyero or Skeirik. Independent claims 8, 15, 24, and 33 have been similarly amended. Applicant respectfully submits that at least in view of these amendments, the pending claims are in a condition for allowance.

New Claim

New claims 68-71 have been added. Claims 68-71 depend variously on independent claims 1, 8, and 33, and are therefore allowable at least for the reasons discussed above.

Moreover, new claim 71 additionally includes:

**receiving a list of values from a configuration expert for use in a batch rule; and
generating the template using the list of values by filling in blanks from a blank
template with the values in the received list of values.**

Examples are provided in Applicant's Specification (e.g., ¶¶ 71-72, among others) of implementations of systems that use batch rules.

These additional limitations are also absent from in the cited passages of the references. At least for this reason, claim 71 is additionally allowable.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5097.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. §§ 1.16 or 1.17, be charged to deposit account 502306.

Respectfully submitted,



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